FILE COPY

Office-Supreme Court, U.S.
FILED
NOV 4 1959
JAMES R. BROWNING, Clerk

In the Supreme Court of the United States

OCTOBER TERM, 1959.

No. 512

UGO MONACO AND MONTECATINI
SOCIETA GENERALE PER L'INDUSTRIA
MINERARIA E CHIMICA ANONIMA,

Petitioners,

v.

ROBERT C. WATSON,
Commissioner of Patents,

Respondent.

PETITION FOR A WRIT OF CERTIORARI
To the United States Court of Appeals For the District of Columbia.

HARRY A. TOULMIN, JR.,
308 West First Street,
Dayton 2, Ohio,
Counsel for Petitioner.

GEORGE W. STENGEL,
Of Counsel.

THE GATEF LEGAL PUBLISHING CO., CLEVELAND, OHIO—MAIN 1-5647

TABLE OF CONTENTS.

Citations to Opinions Below 1

Jurisdiction 2

The Conflict of Decision 2

Question Presented 2

Constitutional Provisions, Statutes and Regulations Involved 3

Statement of the Case 3

A. How the Question Arose 3

B. Practical Aspect 4

C. Purpose of This Petition 4

Reasons for Granting the Writ 5

1. The Court of Appeals for the District of Columbia has rendered a decision in conflict with a decision of the Court of Customs and Patent Appeals 5

2. The Court of Appeals for the District of Columbia has decided a question of Constitutional Law which has not been, but should be, settled by this Court 6

3. The decision of the Court of Appeals for the District of Columbia calls for an exercise of this Court's power of supervision 7

Conclusion 8

APPENDIX (Attached):

Opinion of the United States Court of Appeals for the District of Columbia Circuit 1a

Judgment of United States Court of Appeals for the District of Columbia 4a

Memorandum of the United States District Court for the District of Columbia 5a

Order 6a

Decision of the Patent Office 7a

Constitutional Provisions and Statutes 10a

TABLE OF AUTHORITIES.

Cases.

Allen, In re, 115 F. 2d 936 (CCPA, 1940) 2, 3, 5, 7

Dunn v. Ragin v. Carbide, 50 USPQ 464 (1941) 7

Monaco and Montecatini Societa Generale per l'Industria Minerari E Chimica Anonima vs. Robert C. Watson, Commissioner of Patents, App. D. C., No. 14,937 (1959) 2, 4

Natural Gas Pipeline Co. v. Federal Power Commission, 128 F. (2d) 481 (CCA 7, 1942) 7

Scripps-Howard Radio v. Federal Communications Commission, 316 U. S. 4, 86 L. Ed. 1229, 62 S. Ct. 875 (1942) 7

Simmons v. Stern, 9 F. (2d) 256 (C. C. A. 8, 1925) 5

Smith v. Watson, 318 F. (2d) 863 6

U. S. Rubber Co. v. Coe, 146 F. 2d 315 6

Texts.

2 *Am. Jur.* 843-844 (Appeal and Error § 2) 5

3 *Am. Jur.* 192 (Appeal and Error; Sec. 528) 7

Constitution and Statutes.

Constitution of the United States, Art. I, Sec. 8, cl. 8 3, 6, 10a

5 U. S. C. 1009(d) 3, 7-8, 10a

28 U. S. C. 1254(1) 2

35 U. S. C. 135 3, 6, 11a

35 U. S. C. 141 3, 5, 11a

35 U. S. C. 146 3, 4, 5, 12a

In the Supreme Court of the United States

OCTOBER TERM, 1959.

No.

UGO MONACO AND MONTECATINI
SOCIETA GENERALE PER L'INDUSTRIA
MINERARIA E CHIMICA ANONIMA,

Petitioners,

v.

ROBERT C. WATSON,
Commissioner of Patents,

Respondent.

PETITION FOR A WRIT OF CERTIORARI To the United States Court of Appeals For the District of Columbia.

Petitioners pray that a writ of certiorari issue to review the judgment of the United States Court of Appeals for the District of Columbia, which was entered in the above entitled case on August 27, 1959.

CITATIONS TO OPINIONS BELOW.

The opinion of the Court of Appeals for the District of Columbia, printed in the Appendix hereto at page 1a, is unreported. The United States District Court for the District of Columbia wrote no opinion, except the memorandum and order which are printed in the Appendix hereto at pages 5a and 6a. The memorandum opinion of the Commissioner of Patents is unreported and is printed in the Appendix hereto at pages 7a-10a.

JURISDICTION.

The judgment of the Court of Appeals was entered on August 27, 1959, and is printed in the Appendix at page 4a. The jurisdiction of this Court is invoked under 28 U. S. C., Section 1254(1).

THE CONFLICT OF DECISION.

The Court of Customs and Patent Appeals says, "The issuance of a patent must wait until the Patent Office and Courts determine who is the right inventor." *In re Allen*, 115 F. 2d 936 (CCPA, 1940).

The Court of Appeals of the District says, to the contrary, "The Patent Office does not have to wait, even though the same patent will be issued on the same invention to two separate inventors," Judge Burger dissenting, in *Ugo Monaco and Montecatini Societa Generale per l'Industria Minerari E Chimica Anonima vs. Robert C. Watson, Commissioner of Patents*, App. D. C., No. 14,937. (1959).

QUESTION PRESENTED.

There is **diversity of opinion between two Courts of Appeals of the United States** on the following question, said by the Patent Office Manual to be of "transcendent importance" to the integrity of the United States Patent System, i.e. who is the first inventor to whom the patent should be granted? The question is:

Can the United States Patent Office legally issue two separate patents for the same invention to two different inventor contestants in a Patent Office Interference, involving the question of who is the first inventor, without awaiting the final decision of the reviewing courts as to who, after final determination, is the inventor and who should receive the patent?

CONSTITUTIONAL PROVISIONS, STATUTES AND REGULATIONS INVOLVED.

The constitutional provision involved herein is Art. I, Section 8, Cl. 8. The Statutes involved are: 35 U. S. C., Sections 135, 141 and 146; and 5 U. S. C., Section 1009(d). The constitutional provision and statutes are printed in the Appendix at pages 10a-13a.

STATEMENT OF THE CASE.

A. HOW THE QUESTION AROSE.

The Patent Office withholds issue of the patent if the appeal is to the Court of Customs and Patent Appeals. It declines to do so if the appeal is to the United States District Court for the District of Columbia. We do not know any sound reason for this serious discrimination.

The petitioner Montecatini* and its inventor, Monaco, are citizens of Italy. They have a Patent Office Interference with a citizen of the United States, Hoffman. The Patent Office decided adversely to Montecatini and Monaco. That decision is now awaiting review in the United States District Court of the District of Columbia under Section 146 of the Patent Code which requires that a foreigner can only secure a review of an adverse Patent Office decision in the District Court of the District of Columbia and its Court of Appeals. The Court of Customs and Patent Appeals, pursuant to its decision of *In re Allen*, 115 F. 2d 936 (CCPA 1940) holds that, as the appeal to it from the final decision of the Patent Office in the Patent Office Interference is to determine who is the first inventor, the Patent Office must suspend the issuance of the patent until that Court can determine who is the first and original inventor.

---

* Full names on page 2.

Montecatini and Monaco could not go to the Court of Customs and Patent Appeals because they are foreigners. They must go on appeal for a *de novo* trial to the United States District Court of the District of Columbia and its Court of Appeals under Section 146 of the Patent Code. This case of Montecatini and Monaco is now pending in that court awaiting trial, *Monaco et al v. Hoffman*, Civil Action No. 2026-58. The District Court and Court of Appeals of the District of Columbia, Judge Burger dissenting, held that the Patent Office need not withhold the issuance of the patent. *Monaco and Montecatini v. Watson*, No. 14,937. Therefore, the Patent Office can immediately issue the patent to Hoffman, the winner in the Patent Office proceeding.

This would result in two patents being issued for the same invention.

B. PRACTICAL ASPECT.

The United States Courts have enough trouble with one patent at a time on one invention without complicating the situation by having two patents issued by the Patent Office for the same invention. The position of the Patent Office, as taken in the Courts of the District, would result in a disastrous and confusing situation.

C. PURPOSE OF THIS PETITION.

The purpose of this petition is to reverse the District Court of Columbia so that the Commissioner of Patents will be restrained from issuing an illegal patent to Hoffman, the American, until the question can be finally settled by the United States District Court of the District of Columbia and the United States Court of Appeals of the District of Columbia, as to who is the first and true inventor, in the only tribunal open to a foreigner. (35 U. S. C. § 146.)

REASONS FOR GRANTING THE WRIT.

The writ of certiorari is requested in this case for the following reasons:

1. The Court of Appeals for the District of Columbia has rendered a decision in conflict with a decision of the Court of Customs and Patent Appeals.

The Court of Customs and Patent Appeals has held that the Commissioner of Patents does not have jurisdiction to issue a patent while an appeal is pending in that Court. *In re Allen*, 115 F. 2d 936, 28 CCPA 792 (1940). That was recognized by both the majority and dissenting opinion in the Court below.

A foreigner is forced to go to the United States District Court under Section 146 of the Patent Code: That decision by Congress should not deprive him of the same rights that he would have had if he had gone to the Court of Customs and Patent Appeals, i.e. the withholding of a patent to his opponent when the case goes up for court review of the Patent Office decision.

The majority opinion in the Court below distinguishes the *Allen* case on ground that a proceeding for review by a District Court is a proceeding "de novo and not an appeal." The only difference between an appeal to the Court of Customs and Patent Appeals (under 35 U. S. C. § 141) and a proceeding for review by a district court (under 35 U. S. C. § 146) is that the scope of review by a district court is broader.

The two methods of review correspond to review by writ of error at common law and the appeal in equity. See 2 *Am. Jur.* 843-844 (Appeal and Error § 2). As the Court held in *Simmons v. Stern*, 9 F. (2d) 256 (C. C. A. 8, 1925):

> "An appeal in equity is a trial de novo. Dower v. Richards, 151 U. S. 658, 663, 14 S. Ct. 452, 38 L. Ed. 305; Central Improvement Co. v. Cambria Steel Co.,

210 F. 696, 700, 127 C. C. A. 184; Anderson v. Hultberg, 247 F. 273, 279, 159 C. C. A. 367; Emerson Brantingham Implement Co. v. Johnson (C. C. A.) 1 F. (2d) 212."

The dissenting opinion in the Court below states:

"For purposes of the Commissioner's interim jurisdiction I can see no difference between an appeal to the CCPA under 35 U. S. C. § 141 and a suit for review in a District Court under 35 U. S. C. § 146."

2. The Court of Appeals for the District of Columbia has decided a question of Constitutional Law which has not been, but should be, settled by this Court.

The Constitution limits a patent monopoly to the correct inventor or inventors of a single patent. Const., Art. I, § 8, Cl. 8. Therefore, issuing two patents for the same invention to different inventors is unlawful. *The public gives up enough when a monopoly is granted to one inventor and should not be burdened with dual monopoly.*

If a patent is issued to the winning party to an interference, and the loser is ultimately successful in the Courts, *there will be two patents outstanding* on the same invention. Although 35 U. S. C. § 135 provides for the cancellation of claims from a patent if the losing party to an interference is ultimately successful, that is not tantamount to cancellation of the patent. The patent is still outstanding, and claims which do not read directly on the counts of the interference are unaffected. Where the patent is withheld pending review of an interference proceeding, the Patent Office will re-examine the claims allowed in the light of the Court's decision. *Smith v. Watson*, 318 F. (2d) 863; *U. S. Rubber Co. v. Coe*, 146 F. 2d 315.

The majority of the Court below held that 35 U. S. C. § 135 authorizes the Commissioner to issue a patent while

a proceeding for review is pending in a District Court. *That statute makes no distinction between appeals to the Court of Customs and Patent Appeals and proceedings for review by a District Court.* After the statute was enacted the Patent Office at first construed it as authorizing the withholding of the patent in both instances. *Dunn v. Ragin v. Carbide*, 50 USPQ 464 (1941). The decision in *In re Allen*, 115 F. (2d) 936 (CCPA 1940) compelled the Commissioner to withhold the patent when an appeal was taken to that Court. As the dissenting Judge Burger stated in the Court below:

> "This statute clearly makes no distinction between the two routes for review, nor does reason suggest why any such distinction should be made."

3. The decision of the Court of Appeals for the District of Columbia calls for an exercise of this Court's power of supervision.

It is universally recognized that, when an appeal is taken from a trial court or administrative agency, the tribunal from which the appeal is taken can proceed no further with the case because jurisdiction over the action has been transferred to the appellate court. 3 *Am. Jur.* 192 (Appeal and Error, Sec. 528); *In re Allen*, 115 F. (2d) 936 (CCPA 1940).

Moreover, either a trial or appellate court may issue orders to preserve the status quo while a case is pending. *Scripps-Howard Radio v. Federal Communications Commission*, 316 U. S. 4, 86 L. Ed. 1229, 62 S. Ct. 875 (1942); *Natural Gas Pipeline Co. v. Federal Power Commission*, 128 F. (2d) 481 (CCA 7, 1942).

The rule which was followed in those cases has been adopted by the Administrative Procedure Act. Section 10(d) of the Administrative Procedure Act (5 U. S. C.

§ 1009(d)) authorizes every reviewing court to issue necessary orders "to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings."

CONCLUSION.

For the foregoing reasons, the writ of certiorari should be granted. We believe the propriety of granting the writ in this case is apparent from the dissenting opinion in the court below.

Respectfully submitted,

HARRY A. TOULMIN, JR.,
Counsel for Petitioner.

GEORGE W. STENGEL,
Of Counsel.

OPINION OF THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT.

No. 14937.

UGO MONACO AND MONTECATINI SOCIETA GENERALE PER L'INDUSTRIA MINERARIA E CHIMICA ANONIMA, *Appellants*,

vs.

ROBERT C. WATSON, Commissioner of Patents, *Appellee*.

Appeal from the United States District Court for the District of Columbia.

Decided August 27, 1959.

Mr. Harry A. Toulmin, Jr., with whom *Mr. F. E. Drummond* was on the brief, for appellants.

Mr. George C. Roeming, Attorney, United States Patent Office, with whom *Mr. Clarence W. Moore*, Solicitor, United States Patent Office, was on the brief, for appellee.

Before EDGERTON, FAHY, and BURGER, *Circuit Judges*.

PER CURIAM: Appellants had been the losing parties in a Patent Office proceeding in which the board of patent interferences adjudged a different applicant, Paul H. Hoffman, to be the prior inventor. Instead of appealing to the Court of Customs and Patent Appeals, appellants elected to sue in the District Court under 35 U. S. C. § 146 to require the Commissioner to issue the patent to them. That suit is pending in the District Court and is not before us. In a second suit, appellants seek to restrain the Commissioner from issuing the patent to Hoffman while the first suit is pending. The present appeal is from a judgment for the defendant in the second suit.

The statute provides that the "question of priority of invention shall be determined by a board of patent interferences * * * and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." 35 U. S. C. § 135. We think this means just what it says. We see nothing to suggest that applicants who, like these appellants, are adjudged *not to* be prior inventors, can require the Commissioner to withhold the patent while they sue for it under § 146.

The policy of the statute is clear. The decision of the board of patent interferences is presumably, though not conclusively, correct. If Hoffman, to whom the board awarded priority, gets the patent, he gets no more than is presumably his. To withhold the patent from him for the benefit of applicants who presumably are not entitled to it would serve no useful purpose. If the appellants win their suit under § 146 their rights will be protected even if the Commissioner has issued the patent to Hoffman in the meantime, for § 135 provides that a "final judgment adverse to a patentee * * *, shall constitute cancellation of * * * the patent * * *."

Pursuant to *In re Allen*, 145 F. 2d 936, 28 CCPA 792, the Commissioner withholds patents while appeals from the Patent Office are pending in the Court of Customs and Patent Appeals. That decision and that practice do not concern us. Appellants' suit under § 146 "is de novo and not an appeal." *Knutson v. Gallsworthy*, 82 U. S. App. D. C. 304, 314, 164 F. 2d 497, 507. "It is an application to the court to set aside the action of one of the executive departments of the government." *Morgan v. Daniels*, 153 U. S. 120, 124.

Affirmed.

BURGER, *Circuit Judge, dissenting*: Under the holding of the Court of Customs and Patent Appeals in *In re Allen*, 28 C. C. P. A. (Patents), 115 F. 2d 936 (1940), the Commissioner of Patents has *no jurisdiction* to issue a patent to a winning party in an interference proceeding during the pendency of the loser's appeal to the CCPA. It is not a matter of discretion, and so the Commissioner conceded in the District Court, although he argues to the contrary here.

For purposes of the Commissioner's interim jurisdiction I can see no difference between an appeal to the CCPA under 35 U. S. C. § 141 and a suit for review in a District Court under 35 U. S. C. § 146. Before *In re Allen* but subsequently to *Whipple v. Minor*, 115 Fed. 117 (D. Mass 1883) (relied on here by the Commissioner), the Act of 1927 had amended Rev. Stat. § 4915 (1875) so that an appeal to the CCPA or a bill in equity in the District Court were mutually exclusive remedies with identical time limitations. 44 Stat. 1336 (1927). These are provisions analogous in every material respect to present 35 U. S. C. §§ 141 and 146. Thus, although there have historically been differences between these two methods for reviewing a decision in an interference proceeding, the two routes are now procedurally the same and should therefore have the same effect upon the jurisdiction of the Commissioner.

The statute which the Commissioner contends compels him to issue the patent without delay, 35 U. S. C. § 135, had an exact counterpart in force when the CCPA decided *In re Allen*. Rev. Stat. § 4904, as amended, 53 Stat. 1212 (1939). This statute clearly makes no distinction between the two routes for review, nor does reason suggest why any such distinction should be made.

I would therefore hold that the Commissioner of Patents does not have jurisdiction to issue a patent until after the termination of proceedings brought under 35 U. S. C. § 146.

JUDGMENT OF UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA.

This cause came on to be heard on the record on appeal from the United States District Court for the District of Columbia, and was argued by counsel.

On consideration whereof, it is ordered and adjudged by this Court that the judgment of the District Court appealed from in this cause be, and it is hereby, affirmed.

Per Curiam.

Dated: August 27, 1959.

Separate dissenting opinion by Circuit Judge Burger.

MEMORANDUM OF THE UNITED STATES DISTRICT COURT FOR THE DISTRICT OF COLUMBIA.

(Filed Dec. 23, 1958.)

CIVIL ACTION No. 2209-58.

UGO MONACO, *et al.*,
Plaintiffs,

vs.

ROBERT C. WATSON,
Commissioner of Patents,
Defendant.

MEMORANDUM.

The defendant's motion to dismiss is granted.

/s/ EDWARD A. TAMM,
Judge.

Dated: December 23, 1958.

ORDER.

(Filed January 5, 1959.)

This action came on to be heard at this term on motion of defendant, Robert C. Watson Commissioner of Patents, to dismiss the complaint and thereupon, upon consideration thereof, it is this 5th day of January, 1959

ORDERED that the Motion to Dismiss be and it is hereby granted, and that the complaint be and it is hereby dismissed.

/s/ EDWARD A. TAMM,
Judge.

January 2, 1959.

Approved as to form

TOULMIN & TOULMIN,
/s/ By A. H. TOULMIN, JR.,
Attorneys for Plaintiffs.

DECISION OF THE PATENT OFFICE.

U. S. DEPARTMENT OF COMMERCE
PATENT OFFICE

Washington

October 17, 1958

INTERFERENCE No. 87,523

HOFFMAN

vs.

MONACO

PETITION

Ugo Monaco petitions the Commissioner "to withhold granting of the patent to Hoffman on the application involved in the above entitled Interference now terminated in the Patent Office but pending appeal in the Federal Courts." In the interference the junior party Hoffman received the award of priority on July 21, 1958. The petition alleges that "applicant Monaco has appealed to the Federal District Court in a suit filed in the District of Columbia, Florida and Connecticut, which is taken from the decision of the Patent Office of the Board of Interferences and which challenges the issues decided by that Board." The petition as filed on August 14, 1958, was not accompanied by a certificate of service but a petition filed August 18, 1958, which appears to be a duplicate of the original petition, contains a certificate of service on Hoffman's attorneys.

Petitioner's reference to a suit in three different District Courts leaves the nature of this suit in some doubt. Assuming, however, that the "appeal" to which petitioner refers consists of three civil actions under 35 U. S. C. 146, the pendency of these civil actions provides no basis for

the relief requested; see section 1109 of the Manual of Patent Examining Procedure (2nd ed., November 1953). It is well established that the Commissioner may not withhold the issuance of a patent to the winning party in an interference merely because of the filing of a civil suit by the losing party. *In re Sargent*, 1877 C. D. 125, 12 O. G. 475; *Wells v. Boyle*, 1888 C. D. 36, 43 O. G. 753; *McIntyre v. Perry*, 1911 C. D. 92, 169 O. G. 943; *Fischer v. Porter*, 1928 C. D. 13, 368 O. G. 493; *Sanford v. Kepner*, 170 Ms. Dec. 515 (Kepner is patent No. 2,487,447); *In re McDonough* (1955), file of patent No. 2,736,323, paper No. 29. That the Patent Act of 1952 made no change of the law which would aid petitioner's position, was pointed out by the decision of the First Assistant Commissioner in *Eckert and Mauchly v. Williams*, Interference No. 85,809, paper No. 65. (Williams now is patent No. 2,817,477.) A comparison of 35 U. S. C. 135 with R. S. 4904 (35 U. S. C., 1946 ed., 52) shows that the present statute states more explicitly than its predecessor the finality of the decision of the interference tribunal of the Patent Office on the question of priority.

The petition, which includes no citation of authorities supporting the petitioner's position, argues that issuance of a patent to the party Hoffman might result in a patent issuing "to the party not entitled thereto," that "applicant is in substantially the same position as if the case had been appealed to the United States Court of Customs and Patent Appeals," and that "the Patent Office rules require that the patent in the United States be issued to the original and first inventor (see Section 102 Paragraph (f))." But 35 U. S. C. 135 provides that the decision of the Board of Patent Interferences, if adverse to the claim of an applicant, "shall constitute the final refusal by the Patent Office

of the claims involved," and that "the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." The possibility always exists that a United States District Court, in a *de novo* action, may authorize the Commissioner to issue a patent to the plaintiff in that action. This possibility does not, however, affect the finality of the decision of the Board of Patent Interferences on priority. The determination of priority is governed by 35 U. S. C. 135 so that 35 U. S. C. 102 (f) provides no absolute requirement of first inventorship apart from 35 U. S. C. 135. This is illustrated by the second paragraph of 35 U. S. C. 135 and by provision in Rule 232 of a motion to dissolve an interference on the ground that the claims in issue are not patentable to another party. It is apparent that the applicant who does not timely copy claims from a patent or whose application claims may be unpatentable because of a prior publication, for instance, may be in fact a "first inventor," in some sense of the term, but this, without more, would not entitle him to an award of priority or make the issue of a patent to another applicant improper.

The circumstance that the pendency of an appeal under 35 U. S. C. 141 on the interference record might provide an occasion for withholding issuance of a patent to a winning party in an interference does not aid petitioner's cause because the propriety of withholding issuance of a patent to the winning party while an appeal is pending is not under consideration. It is noted, however, that the Patent Office has long recognized a distinction between an appeal on the interference record in the Patent Office and an action *de novo* under 35 U. S. C. 146 (or R. S. 4915) in which additional evidence may be adduced.

The petition is accordingly denied.

/S/ Arthur W. Crocker
First Assistant Commissioner

Toulmin and Toulmin
308 West First St.
Dayton, Ohio (for Monaco)

Brown and Seward
149 Broadway
New York 6, New York (for Hoffman)

CONSTITUTIONAL PROVISIONS AND STATUTES.

Constitution, Art. I, § 8, cl. 8.

The congress shall have power . . .

To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries;

5 U. S. C. § 1009 (d). Relief pending review.

Pending judicial review any agency is authorized, where it finds that justice so requires, to postpone the effective date of any action taken by it. Upon such conditions as may be required and to the extent necessary to prevent irreparable injury, every reviewing court (including every court to which a case may be taken on appeal from or upon application for certiorari or other writ to a reviewing court) is authorized to issue all necessary and

appropriate process to postpone the effective date of any agency action or to preserve status or rights pending conclusion of the review proceedings.

35 U. S. C. § 135. Interferences.

Whenever an application is made for a patent which, in the opinion of the Commissioner, would interfere with any pending application, or with any unexpired patent, he shall give notice thereof to the applicants, or applicant and patentee, as the case may be. The question of priority of invention shall be determined by a board of patent interferences (consisting of three examiners of interferences) whose decision, if adverse to the claim of an applicant, shall constitute the final refusal by the Patent Office of the claims involved, and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor. A final judgment adverse to a patentee from which no appeal or other review has been or can be taken or had shall constitute cancellation of the claims involved from the patent, and notice thereof shall be endorsed on copies of the patent thereafter distributed by the Patent Office.

A claim which is the same as, or for the same or substantially the same subject matter as, a claim of an issued patent may not be made in any application unless such a claim is made prior to one year from the date on which the patent was granted. July 19, 1952, c. 950, § 1, 66 Stat. 801.

35 U. S. C. § 141. Appeal to Court of Customs and Patent Appeals.

An applicant dissatisfied with the decision of the Board of Appeals may appeal to the United States Court of Customs and Patent Appeals, thereby waiving his right to proceed under section 145 of this title. A party to an interference dissatisfied with the decision of the board of patent

interferences on the question of priority may appeal to the United States Court of Customs and Patent Appeals, but such appeal shall be dismissed if any adverse party to such interference, within twenty days after the appellant has filed notice of appeal according to section 142 of this title, files notice with the Commissioner that he elects to have all further proceedings conducted as provided in section 146 of this title. Thereupon the appellant shall have thirty days thereafter within which to file a civil action under section 146, in default of which the decision appealed from shall govern the further proceedings in the case. July 19, 1952, c. 950, § 1, 66 Stat. 802.

35 U. S. C. § 146. Civil action in case of interference.

Any party to an interference dissatisfied with the decision of the board of patent interferences on the question of priority, may have remedy by civil action, if commenced within such time after such decision, not less than sixty days, as the Commissioner appoints or as provided in section 141 of this title, unless he has appealed to the United States Court of Customs and Patent Appeals, and such appeal is pending or has been decided. In such suits the record in the Patent Office shall be admitted on motion of either party upon the terms and conditions as to costs, expenses, and the further cross-examination of the witnesses as the court imposes, without prejudice to the right of the parties to take further testimony. The testimony and exhibits of the record in the Patent Office when admitted shall have the same effect as if originally taken and produced in the suit.

Such suit may be instituted against the party in interest as shown by the records of the Patent Office at the time of the decision complained of, but any party in interest may become a party to the action. If there be adverse

parties residing in a plurality of districts not embraced within the same state, or an adverse party residing in a foreign country, the United States District Court for the District of Columbia shall have jurisdiction and may issue summons against the adverse parties directed to the marshal of any district in which any adverse party resides. Summons against adverse parties residing in foreign countries may be served by publication or otherwise as the court directs. The Commissioner shall not be a necessary party but he shall be notified of the filing of the suit by the clerk of the court in which it is filed and shall have the right to intervene. Judgment of the court in favor of the right of an applicant to a patent shall authorize the Commissioner to issue such patent on the filing in the Patent Office of a certified copy of the judgment and on compliance with the requirements of law. July 19, 1952, c. 950, § 1, 66 Stat. 803.

FILE COPY

Office-Supreme Court, U.S.
FILED
DEC 2 1959
JAMES R. BROWNING, Clerk

No. 512

In the Supreme Court of the United States

OCTOBER TERM, 1959

UGO MONACO and MONTECATINI SOCIETA GENERALE PER L'INDUSTRIA MINERARIA E CHIMICA ANONIMA, PETITIONERS

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

J. LEE RANKIN,
Solicitor General,

GEORGE COCHRAN DOUB,
Assistant Attorney General,
Department of Justice,
Washington 25, D. C.

INDEX

	Page
Opinion below	1
Jurisdiction	1
Question presented	2
Statement	3
Argument	3
Conclusion	4

CITATIONS

Cases:

Allen, In re, 115 F. 2d 936	3
Norman v. *Schmidt*, 125 F. 2d 162	1

Statutes:

35 U.S.C. 135	2, 3, 4
35 U.S.C. 146	2

Miscellaneous:

S. Rept. No. 877, 76th Cong., 1st Sess.	3

In the Supreme Court of the United States

OCTOBER TERM, 1959

No. 512

UGO MONACO and MONTECATINI SOCIETA GENERALE PER L'INDUSTRIA MINERARIA E CHIMICA ANONIMA, PETITIONERS

v.

ROBERT C. WATSON, COMMISSIONER OF PATENTS

ON PETITION FOR A WRIT OF CERTIORARI TO THE UNITED STATES COURT OF APPEALS FOR THE DISTRICT OF COLUMBIA CIRCUIT

BRIEF FOR THE RESPONDENT IN OPPOSITION

OPINION BELOW

The opinion of the Court of Appeals for the District of Columbia Circuit (R. 55-57) is reported at 270 F. 2d 335.

JURISDICTION

The judgment of the Court of Appeals was entered on August 27, 1959 (R. 58). The petition for a writ

of certiorari was filed on November 4, 1959. The jurisdiction of this Court is invoked under 28 U.S.C. 1254(1).

QUESTION PRESENTED

Whether the Commissioner of Patents is prohibited from issuing a patent to the winning party in an interference proceeding during the pendency of an action by the losing party in the district court under 35 U.S.C. 146 to require the Commissioner to recognize its priority.

STATEMENT

This action was brought to enjoin the respondent from issuing a patent to the winning party in an interference proceeding during the pendency of the petitioners' civil action in the district court to require recognition of their priority.

The petitioners had filed an application for letters patent in the United States Patent Office, and the Commissioner of Patents had determined that the invention described therein interfered with a pending application by one Hoffman (R. 2). Pursuant to 35 U.S.C. 135, the conflicting applications were referred to the Board of Patent Interferences for a finding as to which party was the prior inventor. The Board determined the issue of priority of invention in favor of Hoffman (R. 3). The petitioners then brought a civil action, under 35 U.S.C. 146, in the district court to require the Commissioner to issue them the patent (R. 3). Upon the Commissioner's denial of the petitioners' request to hold up issuance of the patent to Hoffman, petitioners brought this action in the Dis-

trict Court for the District of Columbia (R. 4). The district court granted respondent's motion to dismiss (Pet. 5a-6a) and the court below affirmed, Judge Burger dissenting (Pet. 1a-3a).

ARGUMENT

This case involves a narrow question of construction of the patent laws to determine whether the Commissioner of Patents has jurisdiction to issue a patent to the successful party in an interference proceeding while the unsuccessful party is seeking relief in a district court. The language of the pertinent statute, 35 U.S.C. 135, provides for an adjudication by a Board of Interference Examiners and then states "and the Commissioner may issue a patent to the applicant who is adjudged the prior inventor." The report of the Senate Committee on Patents stated with respect to this provision (S. Rept. No. 877, 76 Cong., 1st Sess., pp. 1-2): "But even when appeal to the court is taken, in many cases it is possible to grant a patent immediately to the winning party without prejudicing the appeal, and in such cases the Commissioner can so grant the patent immediately." Thus, both the language of the statute and its legislative history support jurisdiction in the Commissioner to issue a patent under these circumstances.

The asserted conflict between the court below and the Court of Customs and Patent Appeals does not exist. The decision stated to be in conflict, *In re Allen*, 115 F. 2d 936 (C.C.P.A.), dealt with a distinct review procedure before the Court of Customs

and Patent Appeals[1] and did not purport to decide on the jurisdiction of the Commissioner in the circumstances of the present case.[2]

If the petitioners are successful on the merits, the interfering patent will, under the provisions of 35 U.S.C. 135, be modified to recognize the prior rights of the petitioners. Therefore, the most that is involved is interim relief.

CONCLUSION

For the foregoing reasons, it is respectfully submitted that the petition for a writ of certiorari should be denied.

J. LEE RANKIN,
Solicitor General.

GEORGE COCHRAN DOUB,
Assistant Attorney General.

DECEMBER 1959.

---

[1] In spite of petitioners' assertion that foreigners are precluded from following this alternative review procedure, the Court of Customs and Patent Appeals has accepted jurisdiction in such cases. *Norman* v. *Schmidt*, 125 F. 2d 162.

[2] Actually, the case cited does not even hold that a patent may not be issued by the Commissioner when an appeal to the Court of Customs and Patent Appeals from an interference adjudication is pending since the case dealt only with appeals from the Commissioner's rulings on patentability.

☆ U. S. GOVERNMENT PRINTING OFFICE 1959 532496 727